

REMARKS

INTRODUCTION

In accordance with the foregoing, formal drawings have been submitted, claims 1 and 6-10 have been amended, and new claim 11 has been added. No new matter has been submitted, and reconsideration of the allowability of the pending claims is respectfully requested.

Claims 1-11 are pending and under consideration.

OBJECTION TO THE DRAWINGS

With the aforementioned submission of formal replacement drawings, it is respectfully requested that this rejection be withdrawn.

REJECTION UNDER 35 USC 103

Claims 1, 5, 6 and 10 stand rejected under 35 USC § 103 as being obvious over Saylor, U.S. Patent No. 6,084,372. This rejection is respectfully traversed.

The Office Action indicates that Saylor discloses all the claimed features except for storing data on a start position for starting the synchronism of the follower element and the leading element.

To disclosed this claimed feature, the Office Action sets forth that "[h]owever Saylor does show calculation of a point lock (e.g., figure 8) for subsequent use in acceleration control in the system. It would have been obvious to one of ordinary skill in the art at the time of the invention was made that data regarding such a point lock could be stored as necessary for future utilization since data storage prior to subsequent use is well known."

First, it is noted that the Office Action is attempting to utilize Official Notice to support evidence of a missing features of Saylor.

While "official notice" may be relied upon, as noted in MPEP §2144.03, these circumstances should be rare when an application is under final rejection or action under 37 CFR §1.113. Official Notice unsupported by documentary evidence should be only be taken by the Examiner where the facts asserted to be well known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known and only when such facts are of notorious character and serve only to "fill in the gaps" which might exist in the evidentiary showing made by the Examiner to support a particular ground of rejection.

Further, the applicant should be presented with the explicit basis on which the Examiner

regards the matter as subject to official notice sufficient to allow the applicant a proper opportunity to challenge that assertion. Applicant respectfully requests evidence supporting this Official Notice be produced.

Secondly, even when Official Notice is taken, the Office Action must still provide support in the record for the proffered motivation for incorporation such "well known" features into Saylor.

It is improper to merely deem something obvious without any teaching/suggestion, or the taking of Judicial Notice. If the U.S. Patent and Trademark Office wishes to take Official Notice that the proposed structural and functional modification is notoriously well known, it is respectfully submitted that supporting evidence be provided. The Federal Circuit has cautioned that an Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. In re Rouffet, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998).

No such showing has been made in the present Office Action. It is submitted that the reason why no such showing was made is because the prior art of record individually or combined, fail to teach, suggest, or otherwise provide the motivation needed to make such a modification. "To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination. It is to be noted that simplicity and hindsight are not proper criteria for resolving the issue of obviousness." Ex Parte Clapp, 227 USPQ 972, 973 (B.P.A.I. 1985).

Third, such unsupported modifications of Saylor also appear to reference an 'obvious to try' or 'design choice' rationale for the proffered combination.

To set forth a prima facie obviousness case, evidenced motivation must be provided indicating why one skilled in the art would be motivated, lead, or suggested to modify an existing reference in view of another reference. Specifically, there must be evidence, outside of the present application, which motivates, leads, or suggests to one of ordinary skill to modify a reference. In addition, an "obvious to try" rationale for combining two references is not valid motivation under 35 USC §103. In re Goodwin, 576 F.2d 375, 377, 198 USPQ 1, 3 (CCPA 1978); In re Antonie, 559 F.2d 618, 195 USPQ 6 (CCPA 1977); In re Tomlinson, 363 F.2d 928, 150 USPQ 623 (CCPA 1966).

In addition, is also improper to base a rejection on the claimed feature being merely a design choice. See In re Garrett, 1986 Pat. App. LEXIS 8 (Bd. Pat. App. 1986), where the U.S. Patent and Trademark Office Board of Patent Appeals and Interferences ("Board") specifically

stated: "the examiner has not presented any line of reasoning as to why the artisan would have been motivated to so modify the...structure, and we know of none. The examiner's assertion...that the proposed modification would have been "an obvious matter of engineering design choice well within the level of skill of one of ordinary skill in the art" is a conclusion, rather than a reason." Similar discussions can be seen in *In re Chu*, 36 USPQ2d 1089 (Fed. Cir. 1985).

Fourth, regarding the substance of the Saylor rejection, the independent claims set forth a positional relationship between the leading element and the follower element in synchronism, and a start position for starting the synchronism of the follower element and the leading element are set or stored in advance.

A simple proportional relation (electric gearing), or a simple cam profile relation between the leading element and the follower element, can be represented by a simple mathematical equation. Then trigger point (for point lock) at which the two elements are brought into synchronism can be calculated.

However, regarding a cam profile defined by a free curve, which can be hardly represented by a mathematical equation, it is impossible to obtain the point lock by the calculation according to a mathematical equation. Since Saylor requires the use of a calculation to determine the trigger point, Saylor would not need the aforementioned features, i.e., Saylor is not directed to a free curve and thus would not need the aforementioned features.

Thus, it is respectfully submitted that the aforementioned setting or storing of a start position for starting the synchronism of the leading element and the follower element in advance, for accelerating the follower element from the motion start position to the start position of the synchronism, is patentably distinct from the disclosure of Saylor (or obvious modification of the same). For example, the fact that the system of Saylor can not handle the case when the start position of the synchronism is not obtained by the necessary calculation is further evidence that Saylor fails to disclose or suggest at least these aforementioned features.

Thus, it is respectfully submitted that that the outstanding rejections of the independent claims fail to meet a prima facie obviousness case and that the underlying presumptions, and proffered modifications, of Saylor are unsupported by the disclosure of Saylor, as explained above.

Therefore, for at least all the above, it is respectfully requested that this rejection of claims 1 and 6 be withdrawn and claims 1 and 6 be allowed. In addition, for at least similar rationale, it is respectfully submitted that claims depending from claims 1 and 6 are in proper condition for allowance. For at least similar reasons it is respectfully submitted that new claim 11 is also in proper

condition for allowance. Lastly, it is respectfully submitted that the remaining cited references similarly fail to make up for the deficiencies of Saylor, and similarly fail to provide support or suggestions for the modifications of the same to disclose the presently claimed invention.

CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: _____

3/2/04

By: _____


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